

REMARKS

Claims 1-9, 11-19 and 21-24 are now in the application. The recent telephonic interview with Examiner Nakarani is hereby noted with appreciation. Claims 23 and 24 are newly added. Claims 1-9, 11-19 and 21-24 are all directed to the elected invention.

Claims 1 and 21 have been amended, as discussed during the telephonic interview, to recite that the agglomerates of the heat-insulating particle “have an average particle size of 10 to 100 nm” as disclosed at page 17, lines 4 and 5 of the specification. In addition, as discussed during the telephonic interview, claims 1 and 11 have been amended by deleting the term “carbon tetrachloride”. In addition, as discussed during the telephonic interview, an independent claim (i.e. claim 24) has been presented along the lines of amended claim 1, except that it recites that “the heat-insulating particle has an average primary diameter of 5 to 30 nm” instead of reciting that the agglomerates of the heat-insulating particle “have an average particle size of 10 to 100 nm”. Basis for claims 23 and 24 can be found at page 16, line 25 to page 17, line 2 of the specification.

The amendments to the claims and newly presented claims do not introduce any new matter.

The rejection of Claims 1-4 and 16-19 are rejected under 35 USC 112, first paragraph in reciting “carbon tetrachloride” has been overcome by deleting the term “carbon tetrachloride” from claims 1 and 11.

The rejection of Claims 1-9, 11-19, 21 and 22 under 35 USC 112, first paragraph as failing to comply with the enablement requirement has been overcome by the above amendments to claims 1 and 21 and/or are not deemed tenable. In particular claims 1 and 21 clarify that the agglomerates have an average particle diameter 10 nm to 100 nm. Newly presented claim 24 recites that the heat-insulating particle has an average primary diameter of 5 to 30 nm. Accordingly, persons skilled in the art once aware of the present disclosure could practice the

invention as recited in the generic claims in the absence of undue experimentation. The preferable aspects of the invention need not be recited in the generic claims.

Moreover, with respect to 35 U.S.C. 112, one should be mindful of the following comments by the court in the case of *In re Goffe*, 191 U.S.P.Q. 431:

“For all practical purposes, the Board would limit appellant to claims involving the specific materials disclosed in the examples, so that a competitor seeking to avoid infringing the claims would merely have to follow the disclosure in the subsequently-issued patent to find a substitute. However, to provide effective incentives, claims must adequately protect inventors. To demand that the first to disclose shall limit his claims to what he has found will work or to materials which meet the guidelines specified for ‘preferred’ materials in a process such as the one herein involved would not serve the constitutional purpose of promoting progress in the useful arts.”

In view of the above, consideration and allowance are respectfully solicited.

In the event the Examiner believes another interview might serve in any way to advance the prosecution of this application, the undersigned is available at the telephone number noted below.

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The Office is authorized to charge any necessary fees due with this paper to Deposit Account No. 22-0185, under Order No. 21581-00471-US from which the undersigned is authorized to draw.

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